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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,281	01/16/2001	Paulo Cesar Peregrino Feneira	41826 CIP	1153

466 7590 06/28/2002

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EXAMINER
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ZEMAN, ROBERT A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 06/28/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/759,281	PEREGRINO FERREIRA ET AL.
	Examiner	Art Unit
	Robert A Zeman	1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 April 2002.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2 and 6 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

### **DETAILED ACTION**

The instant application is a continuation-in-part of Application 09/331,262 filed on 7-13-1999. However, since recombinant protein p26 was disclosed only in a general fashion and since SEQ ID NO:1 was not disclosed in Application 09/331,362, all claims reciting SEQ ID NO:1 will receive the filing date of 1-16-2001 (the filing date of the instant application).

Applicant's election of Group I, without traverse, in Paper No. 13 is acknowledged. The amendment filed on 4-12-02 is also acknowledged. Claims 3-5 and 7-9 have been canceled. Claims 1-2 and 6 are pending and currently under examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Birkett et al. (*Biochimica et Biophysica Acta* Vol 1339 No. 1, pages 62-72, April 25, 1997).

The instant claims are drawn to a recombinant protein (EIAV p26 capsid protein) comprising SEQ ID NO:1 and kits comprising said protein.

Birkett et al. disclose a recombinant EIAV p26 capsid protein. Though Birkett et al. do not disclose the sequence of said protein it is deemed, in the absence of evidence to the contrary to be same as, or an obvious variant of, that of the instant invention.

In a discussion of product-by-process claims, this court has said: “[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” *In re Brown*, 59 CCPA 1036, 1041, 459 F.2d 531, 535, 173 USPQ 685, 688 (1972). The court further addressed the issue of product-by process claims in *In re Best*: “the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his

claimed product. Whether the rejection is based on 'inherency' under 35 USC 102, on 'prima facie obviousness' under 35 USC 103, jointly or alternatively, the burden of proof is the same \* \* \*

\* [footnote omitted]." *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The cited reference did not sequence the disclosed protein, but as the products are derived from the same source and by a recombinant process and possess the same properties, they appear to be the same.

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kong et al. (*Microbiology and Immunology*, Vol. 41 No. 12, pages 975-980, 1997)

The instant claims are drawn to a recombinant protein (EIAV p26 capsid protein) comprising SEQ ID NO:1 and kits comprising said protein.

Kong et al. disclose a recombinant EIAV p26 capsid protein. Though Kong et al. do not disclose the sequence of said protein it is deemed, in the absence of evidence to the contrary to be same, or an obvious variant of, as that of the instant invention.

In a discussion of product-by-process claims, this court has said: "[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 59 CCPA 1036, 1041, 459 F.2d 531, 535, 173 USPQ 685, 688 (1972). The court further addressed

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the issue of product-by process claims in *In re Best*: "the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on 'inherency' under 35 USC 102, on 'prima facie obviousness' under 35 USC 103, jointly or alternatively, the burden of proof is the same \* \*

\* [footnote omitted]." In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

The cited reference did not sequence the disclosed protein, but as the products are derived from the same source and by a recombinant process and possess the same properties, they appear to be the same.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are indefinite in reciting "comprising" (claim1) and "having" (claim 2). Since both "comprising" and "having" are generally interpreted as being open language, it is not clear whether the scope of claims 1 and 2 is intended to be the same or different.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claim is rendered vague and indefinite by the use of the phrase "characterized in that it includes". It is suggested that the term "comprising" be used in lieu of said term.

### ***Conclusion***

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Zeman whose telephone number is (703) 308-7991. The examiner can normally be reached on M-Th 7:30 am - 5:00 pm and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donna Wortman can be reached on (703) 308-1032. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



DONNA WORTMAN  
PRIMARY EXAMINER

Robert A. Zeman  
June 27, 2002